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TTAB

February 25, 2008

Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

78229875

Re: Mark: MESSAGE IN A BOTTLE
Opposition No. 91162780

Ladies/Gentlemen:

I am enclosing the Opposer's Opposition to Applicant's Motion for Reconsideration, along with an extra copy of the first page thereof. Please file this document and return the extra page, marked with your filing stamp, in the enclosed stamped, self-addressed envelope.

Thank you.

Very truly yours,


Peter H. Smith

PHS/clf
Enclosures

cc: Mr. Roger Rojas, Message In A Bottle, Inc.



02-27-2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>In the Matter of Trademark Application Serial No. 78/229,875 Mark: MESSAGE IN A BOTTLE</p> <p>MESSAGE IN A BOTTLE, INC., a California corporation, Opposer,</p> <p>v. KEITH CANGIARELLA, Applicant.</p> <p>-----</p> <p>In the Matter of Trademark Registration No. 2,243,269 Mark: MESSAGE IN A BOTTLE</p> <p>KEITH CANGIARELLA, Petitioner,</p> <p>v. MESSAGE IN A BOTTLE, INC., Respondent.</p>	<p>Opposition No. 91162780 and Counterclaim for Cancellation</p>
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OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR RECONSIDERATION

Opposer Message In A Bottle, Inc., hereby states its opposition to Applicant's Motion for Reconsideration of the Trademark Trial & Appeal Board's decision of January 28, 2008, which denied Applicant's second motion for summary judgment, and specifically denied Applicant's request to amend his counterclaim to allege genericness as a ground for cancellation of Opposer's service mark registration for MESSAGE IN A BOTTLE.

Applicant makes a point, as he has done before, of filing his document "in pro per", and attempting to obtain the sympathy of the Board for the fact that he is no longer represented by counsel of record in the present case. However, there is nothing in the law which gives a basis for the Board's excusing actions or failure to act based on a person's acting on his own behalf without counsel.

Indeed, Applicant's argument is hollow here since he was originally represented by counsel,

but allegedly terminated his relationship with counsel and chose to represent himself.

Applicant's argument is particularly hollow in light of the fact that he has filed two motions for summary judgment and various other papers, including the present motion, in an articulate manner, supported with alleged legal citations, in the same manner as if he was represented by counsel of record.

Applicant has said, "The Board would not want to prejudice the Applicant for acting pro se." However, neither would the Board want to favor the Applicant for acting pro se, and this is what the Board would be doing if it overturned its decision of January 28, 2008, on the basis set forth in Applicant's motion.

The timing of Applicant's filing this motion is significant. The Board's decision denying Applicant's second summary judgment motion was dated January 28, 2008. That decision set Opposer's testimony for February 24 through March 25, 2008. On February 5, 2008, Opposer gave notice to Applicant that Opposer would take the testimony deposition of Roger Rojas, Opposer's principal (and the original registrant of MESSAGE IN A BOTTLE) on February 26, 2008. Promptly following receipt of this notice, Applicant commenced a barrage of demands and objections to me in regard to the notice of deposition. Since he had attacked the validity of the notice itself, I contacted the Board, and, at the request of Attorney Andrew Baxley, faxed a copy of the notice to the Board for review. Mr. Baxley reported to me on February 20, 2008, that the notice was sufficient to support going forward with the deposition on February 26, and that he had so notified Applicant by telephone. On the evening of the same day, I received Applicant's present

motion by fax, and on February 21, 2008, the Board suspended the entire proceeding, including Opposer's testimony period and the planned February 26 deposition, pending disposition of Applicant's motion for reconsideration.

Opposer's testimony period previously set to close August 29, 2006, was suspended due to Applicant's first motion for summary judgment. Thereafter, Opposer's testimony period set to close September 21, 2007, was suspended due to Applicant's second motion for summary judgment. It appears that Applicant in filing the present motion is doing the only thing within his power to further prevent Opposer from going forward with its testimony, as the Board in its January 28 decision specifically stated, ". . . the Board finds that no further summary judgment motions are warranted in this proceeding and that this case should accordingly proceed to trial. Therefore, the parties are advised that the Board will not entertain any further motions for summary judgment."

The Board in its January 28 decision was correct on all counts. It found that Applicant unduly delayed in asserting genericness as a ground for cancellation of Opposer's registration, attempting to amend nearly three years after filing the original counterclaim. The Board also acknowledged that prejudice to Opposer would result from allowing such an amendment "as it would inject a new issue into the case on the eve of trial." Applicant has raised no new facts which would provide the Board with any basis for reconsidering its decision.

Furthermore, the ground of genericness should be deemed to be a compulsory counterclaim under TBMP §313.04 and 37 CFR Section 2.106(b)(2)(i). If genericness was ever a potential ground for cancellation, it existed as such at the time the counterclaim was filed. There has been no

great revelation subsequent to the filing that would have given birth to genericness as a new ground. Therefore, Applicant waived this ground by failing to include it in his original counterclaim. Furthermore, a party who fails to timely plead a compulsory counterclaim cannot avoid the effect of his failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed.Cir. 1989).

Finally, Applicant seems to claim that his own counsel failed him by not including genericness as a ground in the original counterclaim. However, it should be noted that if Opposer's registration were vulnerable to a claim of genericness, Applicant's application for the same mark, MESSAGE IN A BOTTLE, would be equally vulnerable. Thus, as Opposer has noted in a previous filing, Applicant's pursuit of this issue is essentially a kamikaze attack which, if successful, would undermine Applicant's own application as well as Opposer's registration. In fact, however, no examiner at the Patent & Trademark Office has raised genericness as an issue at any stage of either of the parties' applications, and MESSAGE IN A BOTTLE is clearly capable of functioning as a mark in the retail trade for selling communication services which utilize bottles.

Dated: February 25, 2008

Respectfully submitted,



PETER H. SMITH

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Message In A Bottle, Inc.

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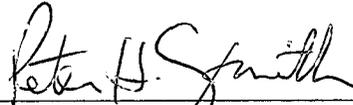
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR RECONSIDERATION was mailed by first-class mail, postage prepaid, to Applicant Keith Cangiarella, DreamWeaver Studios, 331 N. Harrington Drive, Fullerton, CA 92831, on February 25, 2008.



PETER H. SMITH